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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,485	12/05/2003	Cynthia L. Wyngaard	19,525	3112
23556	7590	01/27/2006		
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956				
			EXAMINER BOGART, MICHAEL G	
			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,485

Applicant(s)

WYNGAARD, CYNTHIA L.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1-4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 32 are defined by the degree of elasticity of various components.

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. *Ex parte Slob* (Bd. Pat. App. & Int 1968) 157 USPQ 172; *Austenal*

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Laboratories, Incorporated v. Nobilem Processing Company of Chicago et al.,

115 USPQ 44 (D.C. N. Ill. 1957).

Claim Rejections – 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-5, 8, 9, 11, 12, 16-19, 22 and 26-28 rejected under 35 U.S.C. § 102(b) as being anticipated by Van Gompel *et al.* (US 6,193,701 B1).

Regarding claims 1 and 26, the reference teaches an absorbent article (12) defining a front waist region (14), a back waist region (18), a crotch region (22) that extends between and connects said front and back waist regions (14, 18), a longitudinal direction (L) and a lateral direction (C), an inner surface, an outer surface opposite said inner surface, and a pair of longitudinally opposed end margins and a pair of laterally opposed side margins, said article (12) comprising:

A stretchable outer cover (24);

A stretchable bodyside liner (68) joined to the stretchable outer cover (24) in a superposed relation wherein said outer cover (24) and said bodyside liner (24) are joined along at least a portion of each of said end margins to provide a front waist seam and a back waist seam and wherein said outer cover (24) and said bodyside liner (68) are joined along at least a portion of each of said side margins in said front waist region and said back waist region to provide a pair of side seams (54, 56, 58, 60) in each of said front waist region (14) and said back waist region (18);

An absorbent body (70) disposed between said outer cover (24) and said bodyside liner (68), said absorbent body (70) defining a pair of longitudinally opposed absorbent end edges and a pair of laterally opposed absorbent side edges;

A first left elastomeric suspension member (64, 71) attached to said absorbent body (70) in said front waist region (14); and

A second right elastomeric suspension member (64, 71) attached to said absorbent body (70) in said back waist region (18);

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Wherein said first elastomeric suspension member (64, 71) is sandwiched between said outer cover (24) and said bodyside liner in said pair of side seams in said front waist region (14), and wherein said second elastomeric suspension member (64, 71) is sandwiched between said outer cover (24) and said bodyside liner (68) in said pair of side seams in said back waist region (18)(see figures 1 and 2, below).

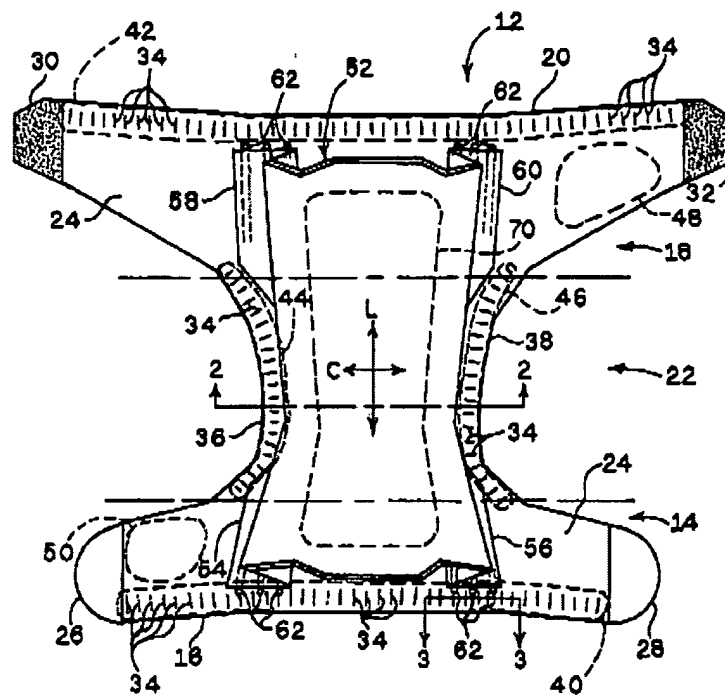


FIG. 1

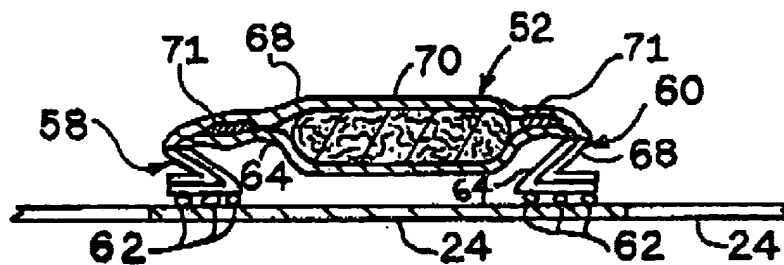


FIG. 2

Regarding claims 16, 18 and 27, the reference teaches that the absorbent body (70) is configured to float between the outer cover (24) and the bodyside liner (68).

Regarding claim 2, the reference teaches that the first suspension member defines a first suspension member (64, 71) width in said lateral direction that is substantially equal to an article width in said front waist region (14) and said second suspension member defines a second suspension member width in said lateral direction that is substantially equal to an article width in said back waist region (18)(figure 1).

Regarding claims 3 and 4, the reference teaches that said first suspension member (64, 71) is sandwiched between said outer cover (24) and said bodyside liner (68) in said front or back waist seam (figure 1).

Regarding claims 5, 19 and 28, the reference teaches that the suspension members (64, 71) are constructed of materials that are inherently biaxially stretchable (col. 11, lines 1-11).

Regarding claim 8, the reference teaches that a portion the suspension members (64, 71) are longitudinally aligned with part of the absorbent member (70)(figure 1).

Regarding claim 9, the reference teaches absorbent materials which are inherently extensible (col. 10, lines 24-65).

Regarding claim 11, the reference teaches an absorbent body that is hourglass-shaped (fig. 1).

Regarding claims 12 and 22, the reference teaches that the outer cover (24) is elastomeric (col. 6, lines 52-61).

Regarding claim 17, the reference teaches that the absorbent body (70) is disposed toward the inner surface relative to the suspension members.

Claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Van Gompel *et al.*

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102.” *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, *supra*.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not

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necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. § 102, on prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Van Gompel *et al.* is silent as to the specific elasticity of the suspension members, outer cover or bodyside liner. The materials disclosed in Van Gompel *et al.* are similar or identical to those described in the specification of instant invention. They can be elongated by 200% (col. 6, lines 36-col. 7, line 65). It is the interpretation of this Office that the disclosed device inherent meets the claimed elasticity.

In an alternative interpretation of the invention for anticipation under 35 USC § 102, in order for someone to actually determine whether or not a particular product meets the limitations of the instantly claimed invention requires subjecting such a product to a specific performance test, making each of claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33 a product-by-process claim.

Product-by-process claims are not limited to the manipulations of the steps, only the structure implied by the steps. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). MPEP § 2113.

Regarding the alternative rejection of claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33 under 35 USC § 103, generally, differences in test characteristics will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Regarding claims 6, 7, 13, 15, 20, 23, 25, 29, 31 and 33, the benefits of optimizing elasticity of the suspenders or layers would have been known prior to applying a test, making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing elasticity increase the ability of the finished product to be comfortably worn by a wearer. MPEP § 2144.04.

Claims 10, 14, 21, 24, 30 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Gompel *et al.* in view of Osborn, III *et al.* (US 5,713,884 A).

Van Gompel *et al.* do not expressly disclose elastic bodyside liners or elastic absorbent bodies.

Osborn, III *et al.* teach an absorbent article having elastic topsheets and absorbent cores (col. 18, lines 15-49; col. 26, lines 35-50).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the elastic body liner and core of Osborn, III *et al.* with the article of Van Gompel *et al.* in order to provide an article that will comfortably comply to the anatomy of a wearer.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Bogart
18 January 2006

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER

